In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 73-1886

HYMIE D. GESSER AND ROBERT E. WARRINER, PETITIONERS

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Petitioners filed an application for a patent on a process for increasing the wettability of plastic contact lenses. The application was rejected by the Patent Office on the ground that petitioner's invention was obvious (Pet. App. A). The Board of Appeals (Pet. App. B) and the Court of Customs and Patent Appeals (Pet. App. C) both affirmed. Petitioner here contends that the Patent Office and the reviewing tribunals erred in failing to inquire into the level of ordinary skill in the field.

To be patentable, an invention must pass the tests of novelty, utility, and non-obviousness set forth in 35 U.S.C. 101, 102, and 103. This Court has stated that the determination of non-obviousness is to be made in the following manner: "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained;

and the level of ordinary skill in the pertinent art resolved." *Graham* v. *John Deere Co.*, 383 U.S. 1, 17. But it is evident from the Court's discussion that the level of ordinary skill in the field is significant only where there is a difference between the prior art and the claims at issue. See *Trico Products Corp.* v. *The Roberk Co.*, 490 F. 2d 1280 (C.A. 2), certiorari denied June 3, 1974, No. 73-1637.

In this case, the Patent Office and the reviewing tribunals determined that there was no difference between the prior art and petitioners' invention, *i.e.*, that their process is fundamentally the same as the art embodied in prior patents. There was therefore no basis for an inquiry into the level of ordinary skill in the field.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

AUGUST 1974.

DOJ-1974-08